

### **REMARKS/ARGUMENTS**

In this Amendment, no claims are amended, no claims are canceled, and claims 61 and 62 are added. After entry of this Amendment, claims 15, 31-34, 36-54 and 57-62 will be pending and subject to examination on the merits.

#### **I. Rejections under 35 U.S.C. §103**

##### **A. van Vliet, Shea, and Williams et al.**

##### **1. Independent claim 15**

At page 2 of the Office Action, claims 15, 28, 31-34, 47-51, 53-56, and 58 are rejected under 35 U.S.C. §103(a) as being unpatentable over van Vliet (US 4,099,749) in view of Shea (US 5,383,994) and Williams et al. (US 5,961,154). This rejection is again traversed.

Obviousness has not been established for a number of reasons.

Regarding claim 15, the Examiner alleges on page 3 of the Office Action that Williams et al. teaches “slip collars are formed with set screws and/or adhesive compositions applied in the slot regions...” However, as argued previously, Williams et al. does not teach or suggest a “curved section comprising apertures” for set screws.

At page 11 of the Office Action, the Examiner alleges that “Applicant’s claim language does not exclude the embodiment disclosed by Williams in which the screws are in apertures that are present in flat flanges, since the curved section of the tubular well outer portion only has to include apertures. There are no limitations in claim 15 that specify that the apertures [are] located **only** on the curved section of the tubular wall portion.” (Emphasis original.)

Applicants disagree and submit that the phrase “wherein the tubular wall outer portion includes a curved section including apertures” clearly indicates that the apertures are in a “curved section.” As such, Applicants submit that it is not necessary to amend the claims to indicate that the apertures are located “only” in the curved section. Applicants maintain that the

obviousness rejection is improper, because of the reasons provided in Applicants' prior Amendment of January 22, 2009.

As additional evidence of non-obviousness, the Examiner is again requested to consider the previously filed 37 C.F.R. 1.132 Declarations of Jeff Shea and Joe Plecnik (as filed on June 28, 2007 and March 1, 2006, respectively). Even assuming, *arguendo*, that the Examiner can allege that the claims are obvious in view of the cited references, Applicants submit that the Declarations provide sufficient evidence to rebut any allegation of obviousness. The Office Action fails to even address the Shea and Plecnik Declarations as evidence of non-obviousness, and Applicants again request that the Examiner explain why the Declarations are not sufficient to overcome any alleged *prima facie* case of obviousness.

For at least these reasons, claim 15, and all claims dependent therefrom, should be allowed.

## **II. van Vliet, Shea, Williams et al., and Jacobson et al.**

### **A. Independent Claim 36**

At page 5 of the Office Action, claims 36-39, 41-44, 46, 52, 57, 59, and 60 are rejected under 35 U.S.C. §103(a) as being unpatentable over van Vliet, Shea, Williams, et al., and Jacobson et al. (US 6,213,522). This rejection is traversed.

Like independent claim 15, independent claim 36 comprises the limitation "wherein the tubular outer portion includes a curved section comprising apertures, and wherein set screws are disposed in the apertures." The Examiner alleges at page 7 that Jacobson et al. "teach that slip collars comprise apertures on a curved section and wherein set screws are disposed in the apertures to provide additional strength once the duct work is assembled. (c. 2, l. 30-34)." The Examiner cites column 2, lines 30-34 of Jacobson et al. as teaching "slip collars comprise apertures on a curved section and wherein set screws are disposed in the apertures to provide additional strength once the duct work is assembled." However, the passage cited by the Examiner states "[i]n a further embodiment, one or more holes are located in the channels in

order to accommodate a screw or similar securing means to provide additional strength once the duct work is assembled.” Nowhere in the cited passage or anywhere else in the specification of Jacobson et al. is there a description of a curved section comprising apertures.

Further, Applicants submit that one would not have modified van Vliet with “set screws,” because this would have been contrary to the intended purpose of van Vliet. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). MPEP 2143.01. Here, column 1, lines 5-16 of van Vliet states:

My invention relates to a coupling member for coupling to each other two channel elements made of sheet material. These channel elements may e.g. consist of sections of an air channel of an air heating device to be used in an air circulation or conditioning system. Such channel elements are usually interconnected by means of screw bolts, rivets, welded joints etc.

My invention aims to provide a coupling member by means of which various channel elements can be interconnected in a manner which is less time consuming and less complicated in comparison with the known connection methods.

As noted above, van Vliet seeks to avoid using “screws” as interconnection elements for two channel elements. If one were to modify van Vliet to include the use of “set screws” as proposed by the Examiner, one would be modifying van Vliet in a manner that is directly contrary to the problem that he is trying to solve. As such, the prior art invention being modified in manner that is unsatisfactory for its intended purpose and the obviousness rejection is improper for yet another reason.

**III. van Vliet, Shea, Williams et al., Jacobson et al., and Nishio; and van Vliet, Shea, Williams, Jacobson et al., and Narukawa et al.**

At page 9 of the Office Action, claim 40 is rejected over the combination of van Vliet, Shea, Williams et al., Jacobson et al., and Nishio (US 6,045,164). At page 10 of the Office Action, claim 45 is rejected over the combination of van Vliet, Shea, Williams, Jacobson et al.,

and Narukawa et al. (US 4,533,020). These rejections are traversed. Each rejection depends on the improper combination of van Vliet, Shea, Williams et al., and Jacobson et al. As noted above, this combination of deficient and the additional citations of Nishio and Narukawa et al. fail to remedy the improper combination.

Further, Applicants submit that the combination of at least three and four references to reject the broadest independent claims, and the use of five references to reject dependent claims 40 and 45 is an indication that improper hindsight was used to reject the present claims. It is well known that “[one] cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.”) (quoting *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988)).

### CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



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